

## REMARKS

Claims 1-8, 16, 19, 22, 24, 25 and 28 are pending. Claims 5, 6, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite. Claims 1-8, 16, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Merjanian. Claims 1-8, 16, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Merjanian in view of U.S. Patent No. 5,933,515 to Pu et al. or U.S. Patent No. 5,465,290 to Hampton et al. or U.S. Patent No. 5,224,173 to Kuhns et al.

Reconsideration is requested. The rejections are traversed. No new matter is added. Claims 1, 3, 4, and 7 are amended. Claim 25 is canceled. Claims 1-8, 16, 19, 22, 24, and 28 remain in the case for consideration.

In rejecting claims 1-8, 16, 19, 22, 24, and 28, the Examiner referred to the reference only as "Merjanian", and was not specific as to which patent by Merjanian was intended. Because the Examiner cited U.S. Patent No. 5,546,471 on a previous form PTO-892, the Applicant is operating on the premise that this was the intended Merjanian reference.

## REJECTIONS UNDER 35 U.S.C. § 112, ¶ 2

The Examiner has rejected claims 5-6, 19, 22, 24-25, and 28 as being indefinite for failing to particularly point out and distinctly claim the subject matter the Applicant regards as the invention. The Examiner has given no specific reason for this rejection for claims 24 and 28; therefore the Applicant treats claims 24 and 28 as rejected for the same reasons as claims 5-6, 19, 22, and 25.

In rejecting claims 5-6, 19, 22, and 25, the Examiner has said that the claims are "improperly presented Markush recitations and hence have plural meanings". Because no further explanation has been provided, it appears to the Applicant that the Examiner has rejected the claims *because* the Examiner believes the claims are Markush claims. This is specifically prohibited: the MPEP indicates that Markush claims are permissible. As stated in MPEP § 2173.05(h): "Genus, subgenus, and Markush-type claims, if properly supported by the disclosure, are all acceptable ways for applicants to claim their inventions." The specification clearly supports these claims, and so they cannot be rejected simply because they recite Markush groups.

In addition, MPEP § 2173.05(h) states that "when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is

clear from their very nature or from the prior art that all of them possess this property." Based on the use of the elements of the group, it is clear that in each of these claims the elements of the group possess a common property. For example, in claim 5, the common property is that the elements can all act as pattern data. Further, it is clear that each of the elements can possess the common property.

Finally, the Applicant fails to understand what the Examiner thought had "plural meanings" in each of the claims. The claim terms seem clear on their face to the Applicant.

As argued in response to the Office Action dated November 19, 2004, the Applicant believes the claims are not Markush groups, but simply lists from which particular features can be selected. It is worth noting that there is generic language available: for example, in claim 22, the list shows different types of biometrics.

Accordingly, the Applicant asserts that the Examiner has failed to make a *prima facie* case that the claims in question are indefinite under 35 U.S.C. § 112, ¶ 2.

#### REJECTIONS UNDER 35 U.S.C. § 102(e)

Regarding the Examiner's comment that the phrase "without the scrip supporter presenting any smartcards or magnetic swipe cards" is a negative limitation, the Examiner is referred to MPEP § 2173.05(i). According to MPEP § 2173.05(i), claims are not inherently ambiguous or uncertain just because they include a negative limitation. And nowhere does the MPEP state that negative limitations are not to be given any weight. The opinion of the court in *In re Wakefield*, 422 F.2d 897, 899, 904, 164 U.S.P.Q. 636, 638, 641 (CCPA 1970) suggests otherwise; if the negative limitation in that case had been given no weight, the claim likely would have failed for reasons of obviousness, if not anticipation, as the claim would then have encompassed a whole host of compounds known in the prior art. Accordingly, the Examiner's decision to assign no weight to the negative limitation is not supported by the MPEP.

Regarding the Examiner's reference to column 10 of Merjanian, the Applicant does not dispute that column 10, lines 8-50 discusses, among other possible uses for the Merjanian system, are to "extract[] information from . . . food stamps" (specifically, at lines 21-22). But the presentation of food stamps, as suggested by the Examiner, involves paper coupons. An electronic scrip transaction has been defined in terms that remain completely electronic, without any paper involvement. Accordingly, the use of paper coupons as suggested by Merjanian is outside the scope of the claims. And Merjanian still fails to use the term scrip anywhere.

Referring to claims 3-4 and 8, the Examiner has stated that "the Medicaid office is read as a clearing house for medical claims/payments. The disclosed matching program using minutiae of the fingerprint characteristics is read as the rule module". While a Medicaid office might be a clearinghouse for medical claims and payments as the Examiner suggests, that does not mean that Merjanian teaches rule modules as claimed. In particular, nowhere does Merjanian teach or suggest the concepts of pattern data and execution commands, let alone their association as claimed in claim 4. Moreover, base claim 3 invoked the rule module after identification is successful, so it does not make sense to read the rule module as the fingerprint matching program in Merjanian.

Referring to claims 5-6, the Examiner has argued that "the PIN is deemed to inherently be an identification code", and that "the donator scout [sic] is the state and the beneficiary account is the food stamp user". There are several problems with these statements. Given that Merjanian makes only one mention of a PIN (at column 11, lines 26-27), it is difficult to say what Merjanian means when referring to the PIN. Given that the rest of the sentence suggests that the PIN could be used "for comparison and identification", that very strongly suggests that the fingerprint does not, in fact, identify the user. If so, then Merjanian fails to teach or suggest many of the other features of the claims. And if Merjanian does not use the PIN for identification purposes, then Merjanian has disclosed a PIN without explaining anything that could be done with it, meaning that Merjanian fails to enable any use of the PIN, which would mean that Merjanian fails to teach or suggest the use of the PIN as claimed in claim 5 of the patent application. Either way, Merjanian fails to teach or suggest all of the features of claim 5.

As for the Examiner's comment about claim 6, the Examiner has focused on particular words in the claim, but ignored the rest of the claim. Specifically, the claim describes an execution command, of which donator accounts and beneficiary accounts are simply a part. It is inappropriate for the Examiner to focus on certain parts of the claims and ignore other parts: the claims should be read as a whole. This is stated explicitly in MPEP § 2106: "the claim as a whole must be considered" (citing to *Diamond v. Diehr*, 450 U.S. 175, 188-189, 209 U.S.P.Q. 1, 9 (1981). As Merjanian does not teach or suggest execution commands, Merjanian does not anticipate claim 6.

#### REJECTIONS UNDER 35 U.S.C. § 103(a)

First, the Applicant takes issue with the fact that the Examiner has rejected claims 1-8, 16, 19, 22, 24, and 28 as being anticipated by Merjanian, but then rejects the claims again as

being unpatentable over Merjanian in view of Pu, Hampton, or Kuhns. Either Merjanian teaches all of the features of the claims or it does not. If Merjanian teaches all the features of the claims, then the rejection under 35 U.S.C. § 103 is inappropriate; otherwise, the rejection under 35 U.S.C. § 102 is inappropriate.

The Examiner argues that Pu, Hampton, and Kuhns "all make clear use of the word 'identification' to describe its system". The Examiner then says that "[i]t would be obvious to modify the system in Merjanian to include the 'tokenless' identification of Pu et al., Hampton et al., and Kuhns et al. with that of Merjanian".

The Applicant disagrees with the Examiner as to all three references. Pu describes a system that relies on multiple fingerprints in sequence to be recognized by the system. Further, at column 11, lines 40-42, Pu describes multiple stages of identification. This means that Pu is not a one-step process as claimed.

Hampton, at column 8, line 15, does not describe "identification"; Hampton states that that it "confirm[s] the identity of a caller". In other words, Hampton is performing verification, and is not an identification system. As has been argued on previous documents, there tends to be some confusion about terminology, and to rely solely on the word used, without examining the underlying operation, is insufficient. Thus, Hampton does not teach an identification system, as suggested by the Examiner.

Finally, whatever Kuhns discusses in column 1, Kuhns states that "[a] classical solution would be to record fingerprints of all persons previously arrested for a crime and search the data bank for a fingerprint match. However, such a search for one fingerprint among millions, for each of many applicants is simply too time consuming, tedious, subject to error, and thus very costly, especially when large numbers of applicants must be verified each day" (column 1, lines 39-45). This teaches away from combining Kuhns with any fingerprint search system.

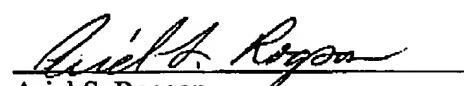
Thus, the mere fact that Pu, Hampton, and Kuhns mention the word "identification" is not enough to make the claimed invention obvious from their combination with Merjanian. In each case, the combination either does not work (i.e., cannot be combined with Merjanian as proposed) or fails to teach or suggest all the features of the claims. Accordingly, claims 1-8, 16, 19, 22, 24, and 28 are allowable.

For the foregoing reasons, reconsideration and allowance of claims 1-8, 16, 19, 22, 24, and 28 of the application as amended is solicited. Given that this application has been

pending for almost six years, the undersigned requests an interview with the Examiner. The Examiner is requested to telephone the undersigned at (503) 222-3613 to schedule this interview.

Respectfully submitted,

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